

Appl. No. 10/072,672  
Amdt. dated Mar. 30, 2006  
Reply to Final Office Action of Dec. 7, 2005

### **REMARKS/ARGUMENTS**

1. The Examiner rejected claims 1, 4, 5, 8, 12-14, 16-26, 29, 30, 33, 40, 41, 44-47, and 53 under 35 U.S.C. § 102(e) as being anticipated by Miller (U.S. Patent Application Publication No. US 2003/0055977 A1). Claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of DeLorme et al. (U.S. Patent No. 5,948,040). Claims 11, 27, 31, 39, 50, and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Brown (U.S. Patent Application Publication No. US 2005/0034161 A1). Claims 1, 4-14, and 16-55 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 7-72 of co-pending U.S. Application Serial No. 09/995,338. Claims 34-36 were objected to due to a dependency problem in claim 34. Reconsideration of this application is respectfully requested in view of the amendments and/or remarks provided herein and the evidence enclosed herewith.

#### **Claim Objections**

2. Claims 34-36 were objected to due to a dependency problem in claim 34. Applicants have herein amended claim 34 to more properly depend from claim 53, as opposed to depending from cancelled claim 2. Based on the amendment to claim 34, Applicants respectfully request that the Examiner withdraw the objection to claims 34-36.

#### **Double Patenting**

3. Claims 1, 4-14, and 16-55 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 7-72 of co-pending U.S. Application Serial No. 09/995,338. While Applicants disagree with the Examiner's assertion that claims 1, 4-14, and 16-55 of the present application are not patentably distinct from claims 5 and 7-72 of co-pending, commonly owned U.S. Application Serial No. 09/995,338, Applicants nevertheless submit herewith a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) in order to move prosecution forward. Since the present application and co-pending U.S. Application Serial No. 09/995,338 are commonly owned and the inventors of the

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subject matter claimed in the present application are identical to the inventors of the subject matter claimed in U.S. Application Serial No. 09/995,338, the enclosed terminal disclaimer disqualifies U.S. Application Serial No. 09/995,338 as prior art in connection with the present application pursuant to 37 C.F.R. § 1.130(b). As a result, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 4-14, and 16-55 under the judicially created doctrine of obviousness-type double patenting.

Rejection under 35 U.S.C. § 102(e)

4. Claims 1, 4, 5, 8, 12-14, 16-26, 29, 30, 33, 40, 41, 44-47, and 53 were rejected under 35 U.S.C. § 102(e) as being anticipated by Miller. Miller was the only reference cited by the Examiner in support of the rejection under 35 U.S.C. § 102(e). Applicants disagree with the Examiner's characterization of Applicants' claims in view of Miller. However, Applicants need not substantively address the disclosure of Miller with respect to Applicants' claims because Applicants conceived of their invention in the United States of America prior to the effective date of Miller and further exercised due diligence continuously from a time prior to the effective date of Miller through the effective filing date of the present application. As a result, Applicants invented the subject matter claimed in the instant application in the United States of America prior to the effective date of Miller. Applicants submit herewith their Declarations of Prior Invention under 37 C.F.R. § 1.131, with accompanying exhibits, to substantiate their claim of prior invention. Applicants submit that the attached evidence shows facts that establish conception of Applicant's invention with due diligence through filing of the instant application prior to the effective date of Miller.

Before discussing the contents of the attached Declarations of Prior Invention, Applicants respectfully request that the Examiner note the guidance provided by M.P.E.P. § 715.07 (Facts and Documentary Evidence) under the subheading of "Establishment of Dates." This subsection of the M.P.E.P. provides as follows:

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or

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her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

In view of the guidance provided by M.P.E.P. § 715.07, Applicants respectfully submit that the removal of dates from an exhibit in support of a declaration under 37 C.F.R. § 1.131 does not render the exhibit evidence insufficient. Rather, in determining the sufficiency of the evidence, the Examiner should examine the body of the declaration to determine whether the matter of dates has been taken care of by the content of the declaration itself. In the attached Declarations of Prior Invention, Applicants have addressed the matter of dates in the bodies of the declarations themselves, specifically in Paragraphs 5 through 11.

Moving now to the contents of the Declarations of Prior Invention, all three Applicants state that they conceived their invention in the United States of America before September 17, 2001, the effective date of the Miller reference. (See Eaton Decl. ¶ 5; Mock Decl. ¶ 5; Hayes Decl. ¶ 5.) Thus, the Declarations of Prior Invention establish that conception of Applicants' invention occurred prior to September 17, 2001. Accordingly, Applicants submit that, although the dates contained in Exhibit A of each Declaration of Prior Invention have been blocked off, the matter of dates has been take care of in the body of each declaration as expressly permitted under M.P.E.P. § 715.07. Therefore, the Examiner should follow the guidance of M.P.E.P. § 715.07 and consider the Declarations of Prior Invention sufficient to establish Applicants' conception of the present invention in the United States prior to the effective date of Miller.

Additionally, Applicants draw the Examiner's attention to Paragraph 9 and the latter portion of Paragraph 5 of each Declaration of Prior Invention in which each Applicant states that due diligence was exercised from prior to September 17, 2001 to work with Motorola's internal patent counsel to prepare and file the present application. The Declarations of Prior Invention thus provide that the invention as evidenced by Exhibit A to each declaration was completed in the United States prior to September 17, 2001. Again, Applicants submit that, although the dates contained in Exhibit A of each Declaration of Prior Invention have been blocked off, the matter of dates has been take care of in the body of each declaration as expressly permitted under M.P.E.P. § 715.07. Therefore, the Examiner should follow the guidance of M.P.E.P. § 715.07

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and consider the Declarations of Prior Invention sufficient to establish Applicants' completion of the present invention in the United States prior to the effective date of Miller.

Based on the enclosed evidence, Applicants conceived of their invention in the United States prior to the effective date of Miller and further used due diligence from prior to the effective date of Miller until the filing of the instant application (U.S. Application Serial No. 10/072,672). As a result, Miller is ineffective as a prior art document with respect to the claims of the instant application. Since Miller is the only reference relied upon by the Examiner to reject claims 1, 4, 5, 8, 12-14, 16-26, 29, 30, 33, 40, 41, 44-47, and 53 of the present application and Applicants have overcome such reference through the submission of their Declarations of Prior Invention under 37 C.F.R. § 1.131, Applicants submit that claims 1, 4, 5, 8, 12-14, 16-26, 29, 30, 33, 40, 41, 44-47, and 53 are in proper condition for allowance and respectfully request that the Examiner pass claims 1, 4, 5, 8, 12-14, 16-26, 29, 30, 33, 40, 41, 44-47, and 53 to allowance.

Rejections under 35 U.S.C. § 103(a)

5. Claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of DeLorme et al. (hereinafter "DeLorme"). Claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 are dependent upon claims 1, 40, and 53, which claims have been shown allowable above. Therefore, since claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 introduce additional subject matter that, when considered in the context of the recitations of their respective base claims, constitutes patentable subject matter, Applicants respectfully submit that the recitations of claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 are not disclosed or suggested by the cited references and respectfully request that claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 be passed to allowance.

In addition, the arguments and evidence presented in Section 2 above, which effectively remove Miller as prior art with respect to claims 1, 40, and 53 of the instant application, are also applicable to effectively remove Miller as prior art with respect to claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 of the present application. DeLorme was applied by the

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Examiner for purposes of allegedly disclosing certain additional limitations present in claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 that were not also allegedly disclosed in Miller (*see* Office Action, pp. 9-12). However, as conceded by the Examiner, DeLorme fails to disclose or suggest all the limitations of Applicants' independent base claims 1, 40 and 53, which limitations are also present in each of claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 due to their individual dependency upon one of the base claims. Therefore, because Miller has been removed as prior art and DeLorme fails to disclose or suggest *all* the limitations of Applicants' claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55, including all the limitations of base claims 1, 40, and 53 and any intervening claims, Applicants respectfully submit that claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 are in proper condition for allowance.

6. Claims 11, 27, 31, 39, 50, and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Brown. With respect to claims 11, 27, 31, 39, 50, and 52, said claims are dependent upon claims 1, 40 and 53, which claims have been shown allowable above. Therefore, since claims 11, 27, 31, 39, 50, and 52 introduce additional subject matter that, when considered in the context of the recitations of their respective base claims, constitutes patentable subject matter, Applicants respectfully submit that the recitations of claims 11, 27, 31, 39, 50, and 52 are not disclosed or suggested by the cited references and respectfully request that claims 11, 27, 31, 39, 50, and 52 be passed to allowance.

In addition, the arguments and evidence presented in Section 2 above, which effectively remove Miller as prior art with respect to claims 1, 40 and 53 of the instant application, are also applicable to effectively remove Miller as prior art with respect to claims 11, 27, 31, 39, 50, and 52 of the present application. Moreover, because Brown was filed after Miller and, therefore, after Applicants conceived of their invention as established by the evidence presented in Section 2 above, the arguments and evidence presented in Section 2 above are also effective to remove Brown as prior art with respect to the claims of the present application. Therefore, because both Miller and Brown have been removed as prior art by Applicants' Declarations of Prior Invention under 37 C.F.R. § 1.131, Applicants respectfully submit that claims 11, 27, 31, 39, 50, and 52 are in proper condition for allowance.

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Impropriety of Final Office Action

7. The Examiner indicated that the present Office Action was made FINAL because Applicants' amendment allegedly necessitated the new ground(s) of rejection. (See Office Action, para. 55.) Applicants strongly disagree with the Examiner's assertions. In Applicants' response filed October 6, 2005, Applicants clearly argued the distinction between Applicants' claimed invention and the references relied upon by the Examiner *without* relying at all upon Applicants' claim amendments. Applicants clearly stated, at page 46, lines 10-17 of their response, that:

Notwithstanding the foregoing, Applicants have herein voluntarily amended independent claims 1 and 40 to clarify the subject matter that was inherently recited in Applicants' claims as originally filed when such claims are properly construed in light of the specification clarify the subject matter that was inherently recited in Applicants' claims as originally filed when such claims are properly construed in light of the specification as required by the Federal Circuit's recent *en banc* decision in *Phillips v. AWH Corp.*, Nos. 03-1269, 03-1286, 2005 WL 1620331 (Fed. Cir. July 12, 2005). Such claim amendments are intended merely to clarify the originally claimed subject matter *and are not being made in any way to distinguish the recitations of claims 1 and 40 from the disclosure of Debonnett or any of the other cited references.*

(Emphasis added.) Applicants also stated, in Section 8 of their prior response, that they had amended all the claims for various other reasons, but that none of those amendments "were intended to narrow the claims in any manner or were made for any purpose related to patentability."

Applicants' assertions that none of the claim amendments made in Applicants' response filed October 6, 2005 were related to patentability are supported by Applicants' arguments distinguishing the Debonnett reference (U.S. Patent Application Publication No. US 2001/0032139 A1) from Applicants' claims. In particular, Applicants' successfully argued that Debonnett did not disclose or suggest the seamless transfer of an ongoing session from a first session client to a second session client (i.e., between clients) in order for the second session client to continue the session. Rather, Debonnett merely disclosed transferring data between servers, not clients. As a result, Debonnett does not disclose or suggest the present invention. The concept of transferring session data between session clients was present in Applicants' originally filed independent claims (*see* original claims 1 and 40). As a result, Applicants'

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amendments to independent claims 1 and 40 were not necessary to distinguish the claims from the disclosure of Debonnett. Rather, as Applicants stated, the voluntary amendments made by Applicants were merely for clarification purposes.

Since Applicants were able to distinguish the recitations of their claims from the references cited in the Examiner's first Office Action without reliance on any of the clarifying claim amendments, Applicants submit that the Examiner's issuance of a final Office Action responsive to Applicants' amendment and response filed October 6, 2005 was improper. Pursuant to M.P.E.P. § 706.07(a), a second or subsequent action on the merits


shall be final, *except* where the examiner introduces a new ground of rejection that is neither *necessitated* by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c).

(Emphasis added.) In the present case, the Examiner introduced a new ground of rejection that was *not necessitated* by Applicants' amendments because Applicants' amendments did not introduce the notion of transferring session information between clients in order to distinguish Applicants' claims from the disclosure of Debonnett. Rather, the transfer of session information between clients was present in *all* of Applicants' original independent claims (claims 1 and 40). The primary distinction between the recitations of Applicants' claims and the disclosure of Debonnett, the primary reference relied upon by the Examiner in the first Office Action on the merits, was the transfer of session information between clients, as opposed to servers as disclosed in Debonnett. Because the transfer of session information between clients was present in Applicants' originally presented claims, Applicants' claim amendments did not *necessitate* the Examiner's newfound reliance upon Miller, DeLorme, and Brown. Rather, the Examiner's new reliance upon Miller, DeLorme and Brown was necessitated by Debonnett's (and the other previously cited references') failure to disclose the subject matter of Applicants' originally filed claims. As a result, the finality of the present Office Action is improper under M.P.E.P. § 706.07(a). Accordingly, Applicants respectfully request that the finality of the present Office Action be withdrawn.

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8. The Examiner is invited to contact the undersigned by telephone, facsimile or email if the Examiner believes that such a communication would advance the prosecution of the instant application. Please charge any necessary fees associated herewith, including extension of time fees (if applicable and not paid by separate check), to the undersigned's Deposit Account No. 50-1111.

Respectfully submitted,

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